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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/732,788	12/11/2000	Masayuki Kondo	Q62242	2735

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EXAMINER

NGUYEN, THUKHANH T

ART UNIT	PAPER NUMBER
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1722

DATE MAILED: 02/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/732,788

Applicant(s)

KONDO, MASAYUKI

Examiner

Thu Khanh T. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3 and 5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3 and 5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 3 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Birchler et al (4,043,027) in view of Seki (5,759,052).

Birchler et al disclose an apparatus for forming terminal connecting portion of conductor wires (Figs. 8a-c), comprising an upper mold (62) with a dome-shaped ceiling face (66) having a curvature to form a corresponding curve on the product (110), and a lower mold (60) having vertical side faces (both side of the cavity 64) and a bottom face (65) which defines a lower part of the molding cavity. Birchler et al disclose the product (110) is a transistor, but does not disclose a terminal fitting.

Seki discloses a join connector including a plurality of terminals (11, 31), each comprising a flat-plate-shape base plate portion (31e) and an upper curvature face (31c-d); wherein the terminals are connected to the wires at one end and to the bus bar connection portion at the other end.

It would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to modify Birchler et al with a terminal fitting having an upper curvature face as taught by Seki for encapsulating the terminal fitting having a desired shape. "Expressions relating the apparatus to contents thereof during an intended operation are of no significance in

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determining patentability of the apparatus claim.” Ex parte Thibault, 164 USPQ 666, 667 (Bd. App. 1969). Furthermore, “[i]nclusion of material or article worked upon by a structure being claimed does not impart patentability to the claims.” In re Young, 75 F.2d 966, 25 USPQ 69 (CCPA 1935) (as restated in In re Otto, 312 F.2d 937, 136 USPQ 458, 459 (CCPA 1963)).

3. Claims 3 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Saito (5,620,711) in view of Stephens et al (5,620,338) or over Stephens et al in view of Saito.

Saito discloses a mold for forming a waterproof cable, comprising an upper mold (col. 3, lines 8-9) having an inner space provided with dome-like ceiling face (9), which defines an upper part of a molding cavity (7), a lower mold (1) having inner space provided with vertical side faces (both sides 15, 17 along the cavity 7) and a bottom face (7a, the bottom of the cavity 7); wherein the dome-like ceiling face of the upper mold has a curvature so selected as to be coincident with a curvature of on outer face of terminal fitting (39, col. 4, lines 4-10).

Saito fails to disclose a terminal fitting having a curvature upper face.

Stephens et al disclose a universal battery cable assembly comprising molded terminals (50; col. 3, lines) having uniform size and shape, in which the terminals are connected to the wires and having a flat base and an upper curvature face (Figs. 4, 6, 8; 50, 64). Stephens fails to disclose a mold for encapsulating the terminal fitting.

It would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to modify Saito by providing a terminal fitting having a predetermined shape, an upper curvature face, as taught by Stephens et al in order for waterproofing a terminal fitting.

It would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to modify Stephen by providing a mold having an upper and lower mold as taught by Saito for encapsulating the terminals. "Expressions relating the apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim." Ex parte Thibault, 164 USPQ 666, 667 (Bd. App. 1969). Furthermore, "[i]nclusion of material or article worked upon by a structure being claimed does not impart patentability to the claims." In re Young, 75 F.2d 966, 25 USPQ 69 (CCPA 1935) (as restated in In re Otto, 312 F.2d 937, 136 USPQ 458, 459 (CCPA 1963)).

Response to Arguments

4. Applicant's arguments with respect to claims 3 and 5 have been considered but are moot in view of the new ground(s) of rejection.

5. The Applicants have argued that Birchler and Saito fails to disclose an upper mold has a dome-shape ceiling face, which is coincident with the curvature of the upper face of the terminal fitting. Again, it would have been obvious to one of ordinary skill in the art to select the shape of the mold according to the shape of the forming product. Thus, it would have been obvious to one of ordinary skill in the art to modify the shape of mold teaching in Birchler and Saito to accommodate the shape of the desired product. In this case, the desired product could be a terminal fitting having a flat base and an upper curvature surface as taught by Seki ('052) or Stephens et al ('338). Therefore, the shape of the mold in according to the shape of the desired product has little or no patentability weight in an apparatus claim. "Expressions relating the apparatus to contents thereof during an intended operation are of no significance in determining

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patentability of the apparatus claim." Ex parte Thibault, 164 USPQ 666, 667 (Bd. App. 1969).

Furthermore, "[i]nclusion of material or article worked upon by a structure being claimed does not impart patentability to the claims." In re Young, 75 F.2d 966, 25 USPQ 69 (CCPA 1935) (as restated in In re Otto, 312 F.2d 937, 136 USPQ 458, 459 (CCPA 1963)).

Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than function. In re Danly, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). It has been held that a functional limitation asserted to be critical for establishing novelty may, in fact, be an inherent characteristic of the prior art. The applicants is required to prove that the subject matter shown in the prior art does not necessarily possess the characteristics relied on. In re Schreiber, 128 F. 3d 1473, 1478, 44 USPQ 2d, 1432 (Fed. Cir. 1997); See also, In re Spada, 911 F 2d 705, 708, 15 USPQ 2d 1655, 1658 (Fed. Cir. 1977); In re Best, 562 F. 2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977); and Ex Parte Gray, 10 USPQ 2d 1922, 1925 (Bd. Pat. App. & Int. 1989).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thu Khanh T. Nguyen whose telephone number is 571-272-1136. The examiner can normally be reached on Monday- Friday, 6:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda L Walker can be reached on 571-272-1151. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TN



ROBERT DAVIS
PRIMARY EXAMINER
GROUP 1800-1200

2/12/04